

## REMARKS

Claims 10-17 are pending in this application.

The Office Action rejects Claims 10-17 pursuant to 35 USC §101 as being directed to neither a process nor a machine but rather embracing or overlapping two different statutory classes of invention. Regarding independent Claim 10, the Office Action maintains that the first four paragraphs of the claim recite structural elements while only the last two paragraphs recite method elements. The basis of the Examiner's determination that the first four paragraphs recite structural elements is that each of these four paragraphs begins with the word "providing", and the Examiner interprets the word "providing" as a verbal noun expressing the state of being in the condition of "having". ✓

The Applicant maintains that it would be more reasonable to interpret the word "providing" in the transitive sense, i.e., to supply or make available (something wanted or needed). There should be no doubt in a reader's mind that this definition conforms to what the Applicant intended since the Applicant clearly identified in the preamble that claim 10 is a METHOD claim, and that each of the following paragraphs described steps of the claimed method. ✓

For this reason, the Applicant maintains that Claim 10 is in proper form pursuant to 35 USC §101. ✓

The Office Actions rejects Claim 10-17 under 35 USC §112, first paragraph because several of these claims use the term "configured" which, according to the Office Action, gives these claims undue breadth. More specifically, the Action maintains that one skilled in the art would be unable to make and use the invention commensurate with the broad recitation of the *intended use* of the claimed language. ✓

In response, the Applicant maintains that the Applicant's use of the claimed term "configured" in this claim doesn't constitute a recitation of intended use. Rather than describing the manner in which the Applicant intends the apparatus to be employed, the Applicant uses the word "configured" to describe configurations or structures of physical elements according to their functions. The distinction is important. If functional descriptions were always deemed to be non-limiting, then recitation such as "fastener", "screw", "pivot" and "support" would be deemed non-limiting. All "means plus function" limitations would also be non-limiting. ✓

Prevailing case law holds that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed. However, here, the recitations in question all impose structural limitations on structural elements that certain steps refer to. To describe an element as being "configured to close" a fill tube means that the structure of the element is adapted to perform the function of closing the fill tube. This is a structural limitation defined according to its function. It is not a recitation of intended use. ✓

The Applicant maintains that the limitations including the word "configured" are capable of differentiating the claimed apparatus from the prior art of record. Any finding that would preclude functional limitations if this type would also be in conflict with 35 USC §112, paragraph 6. For this reason the Applicant maintains that Claims 10-17 are in proper form under 35 USC §112, first paragraph. ✓

The Office Action rejects Claims 10-17 under 35 USC §112 paragraph 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. More specifically, the Office Action states that Claim 10 is ambiguous because it's directed to neither a process nor a machine, but rather embraces or overlaps two different statutory classes of invention. The Office Action includes no support for this contention so the applicant must assume that the Examiner intends to rely on the same reasoning used with regard to the rejection. ✓

of Claims 10-17 pursuant to 35 USC §101, namely, that the Examiner interprets the gerund “providing” as a verbal noun that expresses the state of being and the condition of “having” – an interpretation that clearly conflicts with the Applicant’s identification of this Claim as a method claim. The Applicant objects to this reasoning for the same reasons set forth above with regard to the rejection of Claims 10-17 under 35 USC §101. ✓

The Office Action rejects Claim 11 as being indefinite under 35 USC §112, paragraph 2, for reciting a Markush group improperly. The Applicant has amended Claim 11 accordingly and has also corrected the minor typographical error pointed out in the Office Action. ✓

The Office Action rejects Claim 10-17 under 35 USC §103(a) as being unpatentable over Galbo in view of Harris.

Regarding Claim 10, the Office Action indicates that it would have been obvious to combine the disclosure of Harris with the teachings of Galbo because such combination would have provided “a mechanism with the cap to deliver the reminder message to a person removing the cap from the filler tube” and because such combination would have provided means “to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere”.

The Applicant maintains that the Office Action doesn’t properly support its obviousness determination. It’s well settled that, to support an obviousness determination, you must show why a skilled person, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. To help reduce the likelihood of hindsight-type analyses in these situations, the courts have held that an examiner, to support an obviousness finding, must show a motivation to combine the references that create the case of nonobviousness. See, e.g., *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998). The motivation to combine may be found either in prior art teachings, the knowledge of persons of ordinary skill in the art, or in the

nature of the problem solved. Id at 1458. The Office Action doesn't show a motivation to combine from any of these sources. Instead, the Office Action quotes passages from Galbo and Harris that describe what each reference would contribute to the combination, i.e., Galbo would contribute "a mechanism with the cap to deliver the reminder message to a person removing the cap from the filler tube" and Harris would contribute means "to seal properly the fuel tank filler necks of vehicles so that, for environmental reasons, fuel vapors are prevented from leaking into the atmosphere". What the Office Action doesn't show is a motivation to combine these elements so as to arrive at the invention of claim 10. If all that were necessary to show motivation to combine were to simply state what each reference contributed toward a combination, then there would be very few patentable inventions.

Regarding Claim 11, the Action indicates that it would have been obvious that the disclosure of Galbo in view of the disclosure of Harris would have been selected in accordance with the limitations of this claim because such selection would have provided the same elements from Galbo and Harris that the Office Action mentioned with regard to Claim 10, above. For the same reasons as set forth above with regard to Claim 10, the Applicant maintains that the Office Action doesn't properly support its obviousness determination because, rather than identifying a motivation to combine, it only states what each reference would contribute to the combination.

The Office Action states no grounds for rejecting Claim 12 as being obvious over Galbo in view of Harris as MPEP 707.07(d) requires. Beyond quoting the statutory basis and citing references, the Office Action does not designate the particular parts of the reference relied on to support the rejection as required under 37 CFR §1.104(c)(2). Neither does the Office Action explain the pertinence of each references, as 37 CFR §1.04(c)(2) where such pertinence is not apparent. The Applicant therefore asks that the Examiner state fully the grounds for rejecting Claim 12 and provide the Applicant a fair opportunity to respond. In any event, the Applicant maintains that Claim 12 patentably defines over Galbo in view of Harris because neither Galbo nor Harris disclose or suggest that a gas cap cover device be provided on the replacement gas cap,

that such gas cap cover device bear the message, or that the cover device include a shell configured to be disposed over a portion of a gas cap and a connector supported on the shell and configured to engage the gas cap and cause the gas cap to rotate when the cover device is rotated.

Regarding Claims 13-17, the Office Action takes "official notice" that both the concepts and the advantages of the elements and limitations in Claim 13-17 were well known and expected in the art by one of ordinary skill at the time of the invention. The Office Action goes onto say that it would have been obvious to include all the elements and limitations of these claims because such selection would have provided the same elements from Galbo and Harris that the Office Action mentioned with regard to Claim 10, above. Again, the Applicant maintains the Office Action does not properly support the obvious determination since it doesn't identify a motivation to combine.

In addition, the Applicant asks that the Examiner reconsider his taking of "official notice" that the concepts and the advantages of the elements and limitations in Claim 13-17 were well known and expected in the art by one of ordinary skill at the time of the invention. The Federal Circuit has held that the question of motivation can't be resolved on subjective belief and unknown authority. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). An obviousness determination relying on what is supposedly well known or a matter of general knowledge requires that such knowledge be articulated in the record as "reasoned findings" and followed by an explanation of how those findings support the conclusion of motivation. *Id.* Common knowledge and common sense may be applied to an analysis of the evidence, but can't substitute for evidence. *Id.* When relying on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. *Id.*

The Office Action provides no evidence that it's well known to install a new gas cap on a vehicle *before* providing a message bearing element on the gas cap as recited in claim 13, or as part of a gas cap exchange program as recited in Claim 14. It

may be well known to apply message-bearing advertisements before installing a gas cap, e.g., during the manufacture of a gas cap, but there's no apparent basis for the Examiner to have taken official notice of the application of a message bearing element to a gas cap *after* the cap has been installed.

There's also no apparent basis for the Examiner to have taken official notice of the claiming of mobile emission reduction credits (MERCs) as recited in claim 15. The Office Action again quotes Galbo and Harris as "providing a mechanism with the cap to deliver a reminder message to the person removing the cap from the filler tube" and providing means "to seal properly the fuel tank filler necks of vehicles . . .", respectively, but the Applicant can see no apparent relationship between these passages from Galbo and Harris and the estimation of vehicle emission reductions due to the replacement of leaking or missing gas caps, or the calculation of corresponding mobile emission reduction credits. The same is true with regard to the selling of MERCs to pollution point sources as recited in Claim 16 and the method of calculating emissions reduction due to gas cap exchange and calculating the corresponding mobile emission reduction credit value as recited in Claim 17. What do these limitations from claims 15-17 have to do with the delivery of a reminder message or properly sealing a fuel tank filler neck?

The Applicant maintains that claims 10-17 patentably define over Galbo in view of Harris. Claims 10-17 recite patentable subject matter and are allowable. Therefore, the Applicant respectfully submits that the application is in condition for allowance and respectfully solicits such allowance. Please favorably reconsider the outstanding Office Action.

I authorize the Assistant Commissioner to charge any deficiencies, or credit any overpayment, in connection with this communication to Deposit Account No. 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE, P.C.

A handwritten signature in black ink, appearing to be "Eric T. Jones", written over a horizontal line.

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